

REMARKS

Reconsideration of the application is requested in view of the above amendments and the following remarks. Claims 10 and 44 have been canceled. Claims 1 and 35 have been amended to include some of the limitations of claims 10 and 44, respectively. The amendments to claims 1 and 35 are additionally supported by Table 17 and the description of example 13 at pages 48-49 of the present specification.

§ 103 Rejections

Claims 1-3, 7, 8, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda (US 6,221,455) in view of Hasman (US 5,526,338). Applicants respectfully traverse this rejection.

Yasuda discloses films constituting the first information recording layer 6 and the layers adjacent to the first information recording layer laminated in the following order:

- The light transmitting layer 7.
- The second dielectric protective film 16 having a thickness of 100 to 200 nm.
- The film of a phase-change material 12 having a thickness of 10 to 30 nm.
- The first dielectric protective film 15 having a thickness of 100 to 200 nm.
- The transparent layer 5 having a thickness not less than 30 nm.

The thickness of the phase-change material 12 by itself is 10 to 30 nm. Thus, even if material 12 is considered by itself, the first information recording layer disclosed by Yasuda falls outside of the range $3 \leq d_2 \leq 9$ of the thickness d_2 (nm) of the first recording layer of claim 1. An advantage of the thickness of the first recording layer being in the range ≤ 9 (nm) is improved light transmittance and improved recording and reproduction as compared to thickness greater than 9 nm. A thickness of the first recording layer ≤ 9 (nm) provides light transmittance of at least 50%. Yasuda fails to disclose or suggest a criticality in the thickness of the first recording layer

or that there is any reason to reduce the thickness of the first recording layer to less than 10 nm. Therefore, Yasuda fails to disclose or suggest every limitation of claim 1.

Hasman fails to remedy the deficiencies of Yasuda as it relates to claim 1. Therefore, Yasuda and Hasman fail to disclose or suggest every limitation of claim 1 and the claims that depend from it.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda in view of Hasman and further in view of Imaino (US 5,555,537). Applicants respectfully traverse this rejection. As discussed above, Yasuda and Hasman fail to disclose or suggest every limitation of claim 1. Imaino fails to remedy the deficiencies of Yasuda and Hasman as they relate to claim 1. Therefore, claim 6 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda in view of Hasman and further in view of Akahira (US 5,527,661). Applicants respectfully traverse this rejection. As discussed above, Yasuda and Hasman fail to disclose or suggest every limitation of claim 1. Akahira fails to remedy the deficiencies of Yasuda and Hasman as they relate to claim 1. Therefore, claim 9 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 1 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aratani (US 6,030,678) in view of Yasuda and further in view of Kikitsu (US 6,240,060). Applicants respectfully traverse this rejection.

Aratani discloses a transparent adhesive layer 5 and light transmissive substrate 1f that separate the first and second information layers 4s and 4f (see Figure 1). The combination of layers 5 and 1f is required by Aratani for distinguishing focal positions in the first and second information layer 4f and 4s. The combination of layers 1f and 5 is greater than 50 μm (see column 4, lines 33-62 of Aratani). Therefore, Aratani fails to disclose or suggest that "the first recording medium and the second recording medium are separated by a distance in the range between 1 μm and 50 μm ," as required by claim 1. Yasuda and Kikitsu fail to remedy the

deficiencies of Aratani as it relates to claim 1. Therefore, Aratani, Yasuda and Kikitsu fail to disclose or suggest every limitation of claims 1 and 4.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Aratani in view of Yasuda and further in view of Kikitsu and still further in view of Welch (US 5,384,797). Applicants respectfully traverse this rejection. As discussed above, Yasuda fails to disclose or suggest every limitation of claim 1. Kikitsu and Welch fail to remedy the deficiencies of Yasuda as it relates to claim 1. Therefore, claim 5 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Aratani in view of Yasuda and Kikitsu and further in view of Moriya (US 5,726,969). Applicants respectfully traverse this rejection. As discussed above, Aratani, Yasuda and Kikitsu fail to disclose or suggest every limitation of claim 1. Moriya fails to remedy the deficiencies of Aratani, Yasuda and Kikitsu as they relates to claim 1. Therefore, claim 11 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 35-37, 41, 42, 44, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda in view of Hasman and further in view of Welch. Applicants respectfully traverse this rejection.

Yasuda and Hasman fail to disclose or suggest every limitation of claim 35 for at least the same reason as discussed above related to claim 1. Specifically, Yasuda and Hasman fail to disclose or suggest a first recording layer having a thickness d_2 (nm) in a range of $3 \leq d_2 < 9$. Welch fails to remedy the deficiencies of Yasuda and Hasman as they relate to claim 35. Therefore, the limitations of claims 35-37, 41, 42, 44, and 46 are not disclosed or suggested by the cited references.

Claim 40 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda in view of Hasman and Welch and further in view of Imaino. Applicants respectfully traverse this rejection. As discussed above, Yasuda, Hasman and Welch fail to disclose or suggest every limitation of claim 35. Imaino fails to remedy the deficiencies of Yasuda, Hasman and Welch as

they relate to claim 35. Therefore, claim 40 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claim 43 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda in view of Hasman and Welch and further in view of Akahira. Applicants respectfully traverse this rejection. As discussed above, Yasuda, Hasman and Welch fail to disclose or suggest every limitation of claim 35. Akahira fails to remedy the deficiencies of Yasuda, Hasman and Welch as they relate to claim 35. Therefore, claim 43 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 47-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda, Hasman and Welch, and further in view of Takeuchi (US 6,424,608). Applicants respectfully traverse this rejection. As discussed above, Yasuda, Hasman and Welch fail to disclose or suggest every limitation of claim 35. Takeuchi fails to remedy the deficiencies of Yasuda, Hasman and Welch as they relate to claim 35. Therefore, claims 47-49 are allowable for at least the reason they are dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 47, 49 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda in view of Hasman and Welch and further in view of Ojima (US 4,908,813). Applicants respectfully traverse this rejection. As discussed above, Yasuda, Hasman and Welch fail to disclose or suggest every limitation of claim 35. Ojima fails to remedy the deficiencies of Yasuda, Hasman and Welch as they relate to claim 35. Therefore, claims 47, 49 and 50 are allowable for at least the reason they are dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 35, 38, 39, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aratani in view of Yasuda and Kikitsu and further in view of Hasman and Welch. Applicants respectfully traverse this rejection.

Aratani, Yasuda and Kikitsu fail to disclose or suggest every limitation of claim 35 for at least the reason stated above related to claim 1. Specifically, Aratani, Yasuda, and Kikitsu fail to disclose or suggest "a separation layer is provided between the first recording medium and the

second recording medium, and the thickness of the separation layers is in the range between 1 μm and 50 μm ," as required by claim 35. Hasman and Welch fail to remedy the deficiencies of Aratani, Yasuda and Kikitsu as they relate to claim 35. Therefore, the limitations of 35, 38, 39, and 46 are not disclosed or suggested by the cited references.

Claim 45 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Aratani in view of the Yasuda and Kikitsu and further in view of Hasman, Welch and Moriya. Applicants respectfully traverse this rejection. Aratani, Yasuda, Kikitsu, Hasman and Welch fail to disclose or suggest every limitation of claim 35. Moriya fails to remedy the deficiencies of Aratani, Yasuda, Kikitsu, Hasman and Welch as they relate to claim 35. Therefore, claim 45 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

In view of the above, Applicants request reconsideration of the application in the form of a Notice of Allowance.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: December 13, 2004



Douglas P. Mueller
Reg. No. 30,300
DPM/JNR:njo:ae